

REMARKS

This responds to the Final Office Action mailed on August 12, 2005, and the references cited therewith.

Claims 20, 28 and 29 are amended; claims 2, 13, and 19 are canceled; as a result, claims 1, 3-12, 14-18, and 20-29 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 3-12, 14-18 and 20-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ortega et al. (U.S. 6,489,968) in view of Goedken (U.S. 6,393,423). Applicant respectfully submits that claims 1, 3-12, 14-18 and 20-29 should not be rejected under 35 U.S.C. § 103 for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitation:

defining the first structure of categories as a first hierarchy of categories and defining the second structure of categories as an alternative second hierarchy of categories...

The Final Office Action contends that the above limitation is anticipated by the following disclosure in Goedken:

Occasionally, the selector 110 may be unable to select an appropriate information custodian 14 for a particular information request message 18 (i.e., no information custodians 14 exist in-the identified category...). In such an instance, the selector 110

may select an alternate category from a predefined hierarchy of categories (see FIGS. 12 and 13). The alternate category may be narrower or more general than the original category. For example, if an information request message 18 contains a subject segment 27 value of "Animals/Bats", but no information custodians 14 are available in the "Animals/Bats" category, an information custodian 14 associated with the "Animals" category or the "Animals/Bats/Radar" category or the "Zoology" category may be selected (e.g. 1000001234; 1000005678; 1000002468; . . .).

Goedken, Col 28, lines 33-49.

The above quote from Goedken describes a selector that selects an information custodian from a hierarchy of categories. The selector usually selects an information custodian from an identified category. Occasionally an information custodian does not exist in the identified category. In such an instance the selector may select an alternate category from the hierarchy of categories. The above quote provides an example for a hierarchy of categories, "Animals/Bats/Radar." If the selector is unable to find an information custodians in the category "Bats" then the selector may select an information custodian from the alternate categories "Animals" or "Radar."

Claim 1 requires a first hierarchy of categories and an alternative second hierarchy of categories. Merely for example, Figure 6 of the present application is a diagram illustrating a first hierarchy of categories (e.g., Actual Categories) and an alternative second hierarchy of categories (e.g., Virtual Categories).

In contrast to the limitations of claim 1, the above quote from Goedken does not describe a first hierarchy of categories and an alternative second hierarchy of categories; but rather, a single hierarchy of categories. Indeed, the above quote from Goedken describes selecting an information custodian from "*alternate categories*" (e.g., "Animals", "Radar") within the single hierarchy of categories (e.g., "Animals/Bats/Radar"); but nowhere does the above quote from Goedken describe a first hierarchy of categories and an alternative second hierarchy of categories. Goedken therefore cannot be said to teach or suggest the above quoted limitations of claim 1 because Goedken describes a single hierarchy of categories and claim 1 requires a first hierarchy of categories and an alternative second hierarchy of categories.

The above remarks are also applicable to a consideration of independent claims 14, 20, 28 and 29. Accordingly, Applicant requests that the above remarks and amendments contained herein also be considered when examining these other independent claims for allow ability.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 3-12, 15-18, and 21-27 under 35 U.S.C. § 103 is also addressed by the above remarks.

In summary, Ortega in combination with Goedken does not teach or suggest each and every limitation of claims 1, 14, 20, 28 and 29 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/733,767

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Title: METHOD AND SYSTEM FOR CATEGORIZING ITEMS IN BOTH ACTUAL AND VIRTUAL CATEGORIES

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4046 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of October, 2005.

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